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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,460	09/02/2004	Norio Miyaura	258317US0PCT	3019
22850	7590	03/05/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
SHIAO, REI TSANG				
ART UNIT		PAPER NUMBER		
1626				
NOTIFICATION DATE		DELIVERY MODE		
03/05/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/505,460

Applicant(s)

MIYURA ET AL.

Examiner

Rei-tsang Shiao, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This application claims benefit of the foreign application: JAPAN 2002-61044 with a filing date 03/06/2002. However, an English-translated version of the foreign priority document has not been filed to the Office, the foreign priority has not been granted.
2. Amendment of claims 1 and 3-11 and addition of claim 12 in the amendment filed on December 19, 2007 is acknowledged. Claims 1-12 are pending in the application. No new matter has been found. Since the newly added claim 12 is commensurate with the scope of the invention, claims 1-12 are prosecuted in the case.

Responses to Election/Restriction

3. Claims 1-12 are pending in the application. The scope of the invention of the elected subject matter is as follows.

Claims 1 and 3-12, in part, drawn to processes of making compounds of formula (V) or (VI), wherein the variable X represents oxygen, sulfur atom or an imino group thereof, the variable Y or Z independently represents $-\text{CH=}$ thereof.

Claims 1 and 3-12, in part, embraced in above elected subject matter, are prosecuted in the case. Claims 1 and 3-12, in part, not embraced in above elected subject matter, and claim 2 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

The requirement is still deemed proper and therefore is made FINAL.

Responses to Amendment/Arguments

4. Applicant's arguments regarding the rejection of claims 1 and 3-11 under 35 U.S.C. 112, first paragraph filed on December 19, 2007 have been fully considered but they are not persuasive. It is noted that the level of the skill in the chemical arts is high, it would require undue experimentation of one of ordinary skill in the art to resolve any iridium-containing catalyst or ligand other than formula (X) or (XI). There is no guidance or working examples present for constitutional any process for the oxidation of an organic substrate, wherein a Lewis base having the ability to coordinate with the univalent iridium is not limited. Incorporation of the limitation of the iridium-containing catalyst or ligand (i.e., formula (X) or (XI)) into claim 1 would overcome this rejection. The newly added claim 12 is also rejected under 35 U.S.C. 112, first paragraph as the same reasons above.

5. Applicant's arguments regarding the rejection of claims 1 and 3-11 under 35 U.S.C. 102(b) or 103(a) over Takagi et al. filed on December 19, 2007 have been fully considered but they are not persuasive. It is noted the publication date of Takagi et al. is August, 2002, which is prior to the instant filing date 09/02, 2004. The rejection of claims 1 and 3-11 under 35 U.S.C. 102(b) or 103(a) over Takagi et al. is maintained. The newly added claim 12 is also rejected under 35 U.S.C. 102(b) or 103(a) as the same reasons of claim 1.

6. Applicant's arguments regarding the rejection of claims 1 and 3-11 under 35 U.S.C. 102(a) or 103(a) over Tagata et al. filed on December 19, 2007 have been fully considered and they are persuasive. Since Tagata et al. is not qualified as prior art, the

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rejection of claims 1 and 3-11 under 35 U.S.C. 102(a) or 103(a) over Tagata et al. has been withdrawn herein.

Claim Objections

7. Claims 1 and 3-11 are objected to as containing non-elected subject matter, i.e., the variable Y or Z independently represents $-N=$, etc. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the paragraph 3, *supra*.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Rei-tsang Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/REI-TSANG SHIAO /

Rei-tsang Shiao, Ph.D.
Primary Patent Examiner
Art Unit 1626

February 22, 2008